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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,795	03/09/2004	George Tzong-Chyi Tzeng	16641-002001	3168

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OCCHIUTI ROHLICEK & TSAO, LLP
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CAMBRIDGE, MA 02138

EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/796,795	Applicant(s) TZENG, GEORGE TZONG-CHYI	
	Examiner Dmitry Suhol	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-52 is/are pending in the application.
- 4a) Of the above claim(s) 22-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,9,11-14 and 16-21 is/are rejected.
- 7) ☒ Claim(s) 5-8,10 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicants appear to state that claims 22-52 should be examined since they were elected for prosecution. Applicants are directed to their response to the election requirement dated 3/15/2007 where applicants clearly elect claims of group I and species a **without traverse** which (as stated by the applicants) are encompassed by claims 1-21. Therefore claims 22-61 have been withdrawn by the examiner and WILL NOT be examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the Markush terminology is improper as it uses the term comprising instead on consisting.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 9, 12-14, 16-19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al (20020183830) in view of Hyodoh et al '750. Su discloses a method for generating a medical device containing all of the claimed limitations including, providing a coil having a plurality of loops (50), for each of the primary loops forming a secondary loop on the primary loop (figure 1, loops 30). Limitations of claims 12 and 18 are inherent in Su. For limitations of claims 13-14, see figures 1 and 3a.

Hyodoh is relied upon to teach that it is known to manufacture a stent with the help of a clip tool (712) that is used by gripping a primary loop portion and rotating the clip to make the process of twisting flexible material that makes up the stent easier and faster (col. 17, lines 20-22). Therefore it would have been obvious to one having ordinary skill in the art to utilize a clip like that of Hyodoh to make the process of twisting of Su easier and faster as such a combination would yield predictable results, especially since Su discloses a method of manufacturing a prototype stent through winding and twisting a flexible member about a mandrel and posts and further states that easier production methods may be developed.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al (20020183830) in view of Bolea et al '291. Bolea is relied upon to teach that it is known to utilize a hook in an environment like that of Su and to rotate such a hook to there by form a loop portion on a primary loop (figures 10-11). Therefore since Su states that

other easier method may be utilized to produce his loops, it would have been obvious to utilize a hook to manufacture his loop to make the process faster and easier.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al (20020183830). The requirement that the loop is an open loop is considered a design choice in that applicants do not state any criticality to such a design and therefore the limitation does not serve to distinguish and it appears that a closed loop stent would function just as well as an open loop stent.

Allowable Subject Matter

Claims 5-8, 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 11/5/2007 have been fully considered but they are not persuasive. Applicants argue that there is no motivation to combine the references of Su and Hyodoh. In response the examiner points out that both methods are directed to the manufacture of a medical stent, Su (as stated above) discloses a method of manufacturing a prototype stent through winding and twisting a flexible member about a mandrel and posts and further states that easier production methods may be developed, while Hyodoh teaches the benefits of using a clip to twist wire elements

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which go into the manufacture of a stent (specifically making twisting the wire elements easier and faster). Therefore the combination of the above references is proper and would have yielded predictable results.

Applicants present similar arguments with respect to the combination of Su and Bolea. In response the examiner points out that Bolea is relied upon to teach that it is known to utilize a hook in an environment like that of Su and to rotate such a hook to there by form a loop portion on a primary loop (figures 10-11). Therefore since Su states that other easier method may be utilized to produce his loops, it would have been obvious to utilize a hook to manufacture his loop to make the process faster and easier as such a combination would yield predictable results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Primary Examiner
Art Unit 3725

ds